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077142,888	01/11/88	GIBSON S	SPC6947/6970

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PESELEV, E. EXAMINER

ART UNIT	PAPER NUMBER
183	13

DATE MAILED: 03/12/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 12-14-90 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I - THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892. 2. ☐ Notice re Patent Drawing, PTO-948. ...
3. ☐ Notice of Art Cited by Applicant, PTO-1449. 4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474. 6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-35 and 40 are pending in the application.
- Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-35 and 40 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

EXAMINER'S ACTION

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Claims 1-4, 10, 12, 17-18, 22, 26, 28, 33-35 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 4,980,370. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the U.S. patent 4,980,370 encompass the instant compounds wherein R2 is C3-C8 cycloalkyl or C6 cycloalkenyl group.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112.

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first paragraph, as failing to provide assurance of permanent availability of the culture to the public through a depository. Such assurance may be in the form of averment or by declaration under oath by the applicant to this effect.

It appears that the practice of this invention requires the use of a microorganism belonging to streptomyces avermitiles. While it is noted that a deposit has been made with the National Collection of Industrial Bacteria, there is no assurance that a restriction on the availability of this strain will be revoked upon the issuance of a U.S. patent based on this application. Such assurance, in the form of a statement under oath, declaration, or averment may be used to overcome this rejection. See MPEP 608.01 (P).

Claims 1-35 and 40 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The terminal Disclaimer submitted by applicants has been entered. Applicant's remarks submitted in the Amendment filed December 14, 1990 have been considered but have not been found persuasive insofar as the above rejections relate to the claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is (703) 308-3975.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Peselev/tf
February 24, 1991

Elli Peselev
**ELLI PESELEV
PATENT EXAMINER
ART UNIT 183**